

## **REMARKS**

### **Claim Status**

Claims 1-18 are presented for examination, with claim 1 being in independent form. No new matter has been added.

### **Overview of the Final Office Action**

As of the Final Office Action Claims 1-5, 8-13 and 16 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,218,790 (“*Jansa*”), while dependent claim 6 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Jansa*. In addition, dependent claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Jansa* in view of U.S. Patent No. 6,641,294 (“*Lefebvre*”).

### **Overview of the Advisory Action**

The Examiner states that the arguments made in Applicants’ After-Final Response are not commensurate with the scope of the claims. The Examiner further states that Applicants’ arguments are mainly directed to what is disclosed in Applicants’ application, rather than the scope of the claims, and that limitations in the specification are not read into the claims. Moreover, the Examiner maintains that all elements in the *Jansa* and *Lefebvre* references are being brought together either through physical connections or by circuit connections, and therefore “integration” in this context meets Applicants’ claim language.

Applicants have carefully considered the Examiner’s rejections and the comments provided in support thereof. For the following reasons, Applicants respectfully assert that all claims presented for examination in the present application are patentable over the cited

references, and request reconsideration of the rejections set forth in the Final Office Action and the Advisory Action.

### **Patentability of the Claims Under 35 U.S.C. §102(b)**

Independent claim 1 includes the limitation “wherein said code is detectable by an evaluation circuit which is integrated in the circuit arrangement”. *Jansa* fails to teach or suggest this limitation.

The Examiner contends (see pg. 5 of the Final Office Action) that:

The term “**integrated**” reading broadly can be interpreted as being “**unified**”. Thus, clearly all elements in the *Jansa* and *Lefebvre* references are being brought together though [sic] either the physical connections or by circuit operation. Evaluation circuit 18 is clearly being unified in the circuit arrangement. [Emphasis Added]

Applicants respectfully assert that the term “integrated”, as used in the claims, must be construed to define that the evaluation circuit forms a part of the circuit arrangement comprising LED components. That is, the claimed evaluation circuit is located in (within) the LED arrangement, as depicted in Fig. 6 of the specification. The Applicants’ specification clearly requires this construction of the term, as contrasted with the Examiner’s contention that the term “integrated” can be more broadly understood as “unified”. The Examiner must adhere to Applicants’ definition of the term “integrated”.

When interpreting the claims of a patent, the court must first examine “intrinsic evidence of record”, i.e., the claims themselves, the specification and the prosecution history. *Vitronics Corp. v. Conceptronic Inc.*, 90 F. 3d 1576, 1582 (Fed. Cir. 1996). The Court looks “... to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention.” *Vitronics*, 90 F.3d at 1582 (citing *Bell Communications Research Inc. v.*

*Vitalink Communications Corp.*, 55 F.3d 615, 620, (Fed. Cir. 1995). "[T]he court starts the decision making process by reviewing the same resources as would [the person of ordinary skill in the field of the invention], viz., the patent specification and the prosecution history." *Phillips v. A.W.H. Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (internal quotation marks and citations omitted)). In construing claims, it is important to remember that it is not the function of the court to rewrite the claims, but rather to give effect to the terms chosen by the patentee. *K-2 Corp. v. Salmon S.A.*, 191 F.3d 1356, 1364 (Fed. Cir. 1999) (*reh'g denied*).

"For claim construction purposes, the description [in the specification] may act as a sort of dictionary, which explains the invention and may define terms used in the claims." *Markman*, 52 F.3d at 979. "Usually [the specification] is dispositive; it is the single best guide to the meaning of a disputed term." *Vitronics*, 90 F.3d at 1582 (quoted with approval in *Phillips*, 415 F.3d at 1315; see also *Watts v XL Sys., Inc.*, 232 F.3d 877, 882 (Fed. Cir. 2000).

Further, when a patentee has acted as his own lexicographer and included a definition of a claim term in the specification, that definition will control, even if it differs from the ordinary meaning. *Abbott Laboratories v. Novopharm Ltd.*, 323 F.3d 1324 (Fed. Cir. 2003

"Judges...may also rely on dictionary definitions when constructing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *CCS Fitness, Inc., v. Brunswick Corp.*, 28 F.3d 1359, 1366 (Fed. Cir. 2002), quoting from *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1584 n. 6 (Fed. Cir. 1996).

Thus, within the context of the claimed invention, it is fundamentally improper for the Examiner to conclude that this expressly claimed feature can be interpreted as "being unified" in

the sense disclosed in *Jansa* because Applicants have defined the word “integrated” to mean located in (within) the LED arrangement.

*Jansa* discloses a device wherein the LED and its connection leads are separated from the evaluation circuit and the drive circuit. *Jansa* (col. 3, lines 61-63) states, “a separating line 9 (shown by dashed lines) runs along a connection element 2 (shown only schematically) which has six contact elements 3-8”. *Jansa* (col. 3, line 63 thru col. 4, line 2) further states that “together with the contact elements 3-8 arranged inside the connection elements 2, which is designed as a male connector, the light-emitting diode 1 forms a physical unit which is arranged such that it can be mechanically separated from the remaining components along the separating line 9, which symbolizes a plug connection”. *Jansa* thus teaches an arrangement in which separate elements, i.e. (a) the light emitting diode, and (b) the evaluation circuit (along with the remaining components), are separated but connected to each other by a plug connector. *Jansa* thus teaches that the evaluation circuit is separated from the LED circuit by a plug connection.

In contrast, a clear distinction is made in the specification of the present application between an embodiment in which the evaluation circuit is separated from the circuit arrangement comprising LED components (see paragraph [0019]), and another embodiment in which the evaluation circuit is integrated in (i.e. located within) the circuit arrangement comprising LED components (see paragraph [0021]). A broad interpretation of the word “integrated” to encompass the Examiner’s suggested meaning of “unified by any electrical or physical connection between these components” is improper, because such an interpretation would simply ignore and discard the difference between these two embodiments. Further, the Examiner’s interpretation of the word “integrated” is an impermissible alteration of Applicants’ intended definition, as described in Applicants’ specification.

Further evidence of the clear intention of the specification to differentiate between embodiments in which the evaluation unit is either integrated in (on the one hand), or separated from (on the other), the circuit arrangement comprising LED components – and thereby limit the intended meaning of the term “integrated” in the claims – is present in paragraph [0066] of the originally filed specification that describes Fig. 6. There, the specification instructs that “the exemplary embodiment shown in figure 6 differs from that described in conjunction with figure 4 in particular by the fact that an evaluation circuit 73 is not integrated in the drive circuit 21, but rather in the LED module 1”. A plug connection is located between the drive circuit 21 and the evaluation circuit 73 in the embodiment of Fig. 6, just as in *Jansa* the LED and the evaluation circuit are separated but electrically connected by a plug connector. Within the context and meaning of the claimed invention, therefore, these components in the Fig. 6 embodiment are not regarded as being “integrated”.

Moreover, an analysis such as that suggested by the Examiner, in which the evaluation circuit and the LED circuit described by *Jansa* (which are connected by a plug) are deemed “integrated” within the meaning of claim 1, would require that the arrangement of Fig. 6 of the instant application likewise be deemed “integrated”. However, Applicants’ specification expressly instructs that these elements in Fig. 6 are not “integrated” (see paragraph [0066]). Thus, the Examiner’s overly broad interpretation of the claim term “integrated” is contrary to the meaning of that term as described and defined in Applicants’ specification. In actuality, the circuit disclosed in *Jansa* cannot meet the claim 1 limitation that “said code is detectable by an evaluation circuit which is integrated in the circuit arrangement”, when the term “integrated” is properly construed in accordance with Applicants’ disclosure.

With respect to the Examiner's assertion that Applicants' arguments are mainly directed to what is disclosed in Applicants' application, rather than the scope of the claims, Applicants submit that the Examiner is incorrect. Applicants' arguments are directed to the proper definition of the word "integrated", and the Examiner's improper altering of that definition. The scope of Applicants' claims can only be determined and argued once the proper definitions of the words in the claims are understood.

In view of the foregoing, independent claim 1 is deemed patentable over *Jansa* and, accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 are requested, and early notice to this effect is in order.

#### **Patentability of the Claims Under 35 U.S.C. §103(a)**

*Jansa* also fails to render the recitations of independent claim 1 obvious, and thus unpatentable. More specifically, it would not be obvious to integrate the evaluation circuit into the electronic circuit arrangement, as claimed, based on that which is taught by *Jansa*. For example, *Jansa* (col. 3, line 63 thru col. 4 line 2) teaches that the LED 1 and the contact elements 3-8 form a physical unit that is mechanically separated from the remaining components, i.e. the evaluation circuit, by a plug connection 2. This separation of the physical unit formed by the LED and the contact elements from the evaluation circuit is emphasized by the separating line 9 shown in Fig. 1 and Fig. 2 of *Jansa*. A person of ordinary level of skill in the art would not be motivated to integrate the evaluation circuit into the electronic circuit arrangement based on the teachings of *Jansa*, since *Jansa* (col. 1, line 59 thru col. 2, line 4) teaches that it is preferable to exclude components, i.e. a single series resistor, from within the LED because doing so would cause a change in the dimensions of the LED structure. Consequently, *Jansa* teaches away from

integrating the evaluation circuit in the electronic circuit, as Applicants recite in independent claim 1.

Integration of the evaluation circuit in the electronic circuit arrangement in accordance with the present invention advantageously eliminates the need to connect the evaluation circuit to the electronic circuit arrangement by connector elements, e.g. a plug element. Eliminating this connector requirement is particularly advantageous when the claimed circuit arrangement is for use in a vehicle, because the integrity of a plug connection may be affected by mechanical vibrations (see, for example, pgs. 2-3, paragraph [0008] of the originally filed specification). Furthermore, the claimed electronic circuit arrangement can advantageously be supplied as a complete module, without the need for an external evaluation circuit. *Jansa* fails to teach or suggest such advantages as are associated with the invention recited in independent claim 1. *Jansa* therefore fails to render independent claim 1 obvious for at least these reasons.

With respect to dependent claims 14 and 15, the Examiner cites *Lefebvre* in an effort to cure the shortcomings of *Jansa*. The combination of *Jansa* and *Lefebvre*, however, fails to achieve the claimed invention because *Lefebvre* also fails to teach or suggest, at least, that “said code is detectable by an evaluation circuit which is integrated in [a] circuit arrangement,” as recited in independent claim 1. Applicants therefore assert that dependent claims 14 and 15 are also patentable over the cited references, when applied individually or in combination, based on their dependency from claim 1. Reconsideration and withdrawal of all of the rejections under 35 U.S.C. §103 are respectfully requested.

### **In re Van Geuns**

The Examiner cites this CAFC decision for the principle that “limitations from the specification are not read into the claims.” In this decision, the CAFC points out the following:

Van Geuns' claim 42 recites a magnet assembly with a "uniform magnetic field." The board found that the Japanese reference disclosed a magnet assembly with a substantially uniform magnetic field, varying no more than 10 percent. Van Geuns does not disagree with this finding. Instead, Van Geuns argues that the uniform magnetic field limitation of claim 42 must be interpreted in light of the specification and the understanding of persons skilled in the NMR and MRI art. Van Geuns then contends that the Japanese reference does not make the invention of claim 42 obvious because it does not teach the level of magnetic field uniformity required for NMR managing. The short answer is that claim 42 is not expressly limited to NMR or MRI apparatus.

In *Van Geuns*, the issue is whether or not NMR is a claimed feature. Since its claim 42 says nothing explicitly about NMR, the NMR feature would have to be imported into the claim in order for this feature to be treated as a claim limitation. In contrast, present claim 1 already explicitly recites the feature of an "integrated" evaluation circuit. The integrated evaluation circuit does not have to be imported into the claim because it is already part of claim 1.

The role of the specification is not that of a reserve source of unclaimed components from which one can be inferentially and arbitrarily imported at will into the claim. This is prohibited by *Van Geuns*. Rather, applicant is relying on the specification to perform its normal and accepted role as intrinsic evidence in claim construction, namely to interpret a term already recited in the claim. Therefore, the Examiner's reliance on *Van Geuns* to reject applicants' argument is misplaced. *Van Geuns* does not apply to the issue at hand pertaining to the meaning of "integrated" which is already explicitly recited in the claims.

It bears emphasizing that an inventor can be his own lexicographer. With this being a well established principle, and with the "integrated" evaluation circuit already being a claimed limitation, its meaning must be interpreted in light of the specification. This the Examiner has so far failed to do. If it is done, and ultimately it will have to be done by the Examiner, by other USPTO personnel, or by a court, then the interpretation urged by applicants in the arguments



presented above will be applied. When construed as such, claim 1 is clearly patentable over *Jansa*.

### **Dependent Claims**

In view of the patentability of independent claim 1, for at least the reasons presented above, each of dependent claims 2-18 is likewise deemed patentable over the prior art. Each of these dependent claims also includes features which serve to distinguish even further the claimed invention over the cited art.

### **Conclusion**

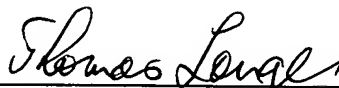
Based on all of the above, it is respectfully submitted that the present application is now in full and proper condition for allowance. Prompt and favorable action to this effect, and early passage of the application to issue, are once more solicited.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate a prompt resolution of any outstanding issues.

Respectfully submitted,

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